

## REMARKS

Reconsideration of the application is requested. Claims 1-7, 16-19, 24, and 26-61 are now in the application. Claims 1-7, 16-19, 24, 26, 32-37, 39-48, 50, and 54-57 have been amended. Claims 58-61 have been added. No new matter has been added.

Support for the amendment of claims 1-7, 16-19, 24, 26, 32-37, 39-48, 50, and 54-57 and the addition of new claims 58-61 can be found throughout the application as originally filed, for example see paragraphs [0002], [0007]-[0016], and [0053]-[0064].

### Terminal Disclaimer

Claims 1-7, 17, 19, 24, 32-39, 44, 46-50, 54, and 55 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-26 of U.S. Patent No. 6,719,765. Further, Claims 40-43, 56, and 57 were rejected in further view of U.S. Patent No. 3,577,991 to Wilkinson. Applicant requests that this rejection be held in abeyance until all other issues regarding patentability are resolved. Should the claims be amended during prosecution, the amended claims may not require a terminal disclaimer. Alternatively, should a conflict remain, Applicant will consider the filing of a timely terminal disclaimer.

### Drawing Objection

In the third paragraph of page 2 of the Office action, the drawings are objected to under 37 CFR 1.83(a), as the Examiner contends that the biasing member as recited in claim 43 must be shown or the feature(s) canceled from the claim(s).

According to 37 CFR 1.81, an applicant is required to furnish a drawing of his or her invention where it is "necessary for the understanding of the subject matter sought to be patented". The objection relates to a biasing member, which does not require a drawing for an understanding of the subject matter. Furthermore, the relevant language is enabled by the specification as originally filed, for example by at least paragraphs [0055], [0056], and [0062].

Accordingly, the Applicant submits that additional drawings should not be required and respectfully request the Examiner to withdraw the objection.

#### Claim Objection

In the second paragraph of page 3 of the Office action, the Examiner objected to claim 43 as containing typographical errors. While the Applicant believes that the claims were clear as previously presented, the Applicants believe that the suggested changes do not affect the scope of the invention. And, in light of the Examiner's recommendation, Applicant has entered the suggested change.

The insertion of the word --to-- between the terms "surface" and "spread" is not done for reasons related to the statutory requirements of a patent or for reasons related to the prior art.

#### 35 USC 112

In the first paragraph on page 4 of the Office action, the Examiner rejected claims 1-7, 24, 32-44, 46-50, and 57 as being indefinite under 35 U.S.C. § 112, second paragraph. More specifically, the Examiner has stated that the claims combined method steps in a device claim.

Claims 1 and 40 have been amended to include the term "wherein" and to change "generating" to --generation of--. Further, claim 1 has been amended to remove the term "driving" and claim 40 has been amended to change "driving" to --to drive--.

Accordingly, the claims meet the requirements of 35 U.S.C. § 112, second paragraph. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent.

35 USC 101

The Examiner rejected claims 1-7, 24, 32-44, 46-50, and 57 under 35 USC 101 as not belonging to one statutory class. As discussed with regard to the 35 USC § 112, second paragraph, rejections, the claims have been amended so that they only cover one statutory class: a machine.

35 USC 102

In the first paragraph on page five of the Office action, the Examiner rejected claims 1, 2, 17, 19, 24, 32, 35-37, 40, 41, 44, 46, and 54-57 as being fully anticipated under 35 U.S.C. § 102(b) by US Patent 5,824,009 to Fukuda et al (hereinafter “Fukuda”). As will be explained below, the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Referring to Fukuda, this reference mentions a “needle body 3a made of a magnet” and “needle receiver 5 made of a magnetic material”, but merely teaches use of a magnet to move a needle relative to a needle receiver. Nowhere does this Fukuda teach 1) a magnetizable material being disposed in at least one of said first and second tissue engaging members, as in claims 1 and 40, 2) a electromagnet disposed in at least one of said first and second tissue engaging members, as in claim 1, 3) a magnetic field generator disposed in at least one of said first and second tissue engaging members, as in claim 40, or 4) wherein generation of a magnetic field moves at least one of said first and second tissue engaging members relative to the other tissue engaging member, as recited in claims 1 and 40. Because Fukuda fails to teach the use of magnetism to move a tissue engaging member relative to another tissue engaging member, this reference fails to anticipate claims 1, 2, 17, 19, 24, 32, 35-37, 40, 41, 44, 46, and 54-57 of the instant application and the Applicant respectfully requests the Examiner to withdraw this 102(b) rejection.

35 USC § 103

In the final paragraph on page 6 of the Office action, the Examiner rejected claims 3-7, 33, 34, 39, 42, and 47-50 under 35 USC § 103(a) as being unpatentable over Fukuda in view of US Patent 6,179,850 to Goradia.

Referring to Goradia, this reference discusses, in its abstract, the use of a “magnetic field . . . to cause the leaf spring to trigger transition of the clip to a closed state”, but does not teach magnetism related to a tissue engaging surface. Furthermore, in column 10, line 27-29, the magnetic field merely relates to an “external electromagnet ... that will cause the leaf-spring element to give way more easily to the force of the main spring”, which is not disposed in a tissue engaging member. Moreover, in column 11, line 60, “a switch-activated solenoid external to the patient can be used to generate a magnetic field to exert a force on a leaf spring”, which is also not disposed in a tissue engaging member. Nowhere, either in alone or in combination, does Goradia discuss 1) a magnetizable material being disposed in at least one of said first and second tissue engaging members, as in claims 1 and 40, 2) a electromagnet disposed in at least one of said first and second tissue engaging members, as in claim 1, 3) a magnetic field generator disposed in at least one of said first and second tissue engaging members, as in claim 40, or 4) wherein generation of a magnetic field moves at least one of said first and second tissue engaging members relative to the other tissue engaging member, as recited in independent claims 1 and 40. Because the rejected claims depend on either claim 1 or 40, the rejected claims are patentable for the same reasons. Therefore, the Applicant respectfully requests the Examiner to withdraw this 103(a) rejection.

In the final paragraph on page 8 of the Office action, the Examiner rejected claim 40 under 35 USC § 103(a) as being unpatentable over Fukuda in view of US Patent 3,577,991 to Wilkinson.

Referring to Wilkinson, this reference discusses that “a plain pin or axle for the hinge can be held in place by the shields 15 on both sides of the members or legs” as stated in column 2, line 39. Shield 15 merely holds the pin or axle in place, but fails to disclose a shield connected to a tissue engaging member or a shield for spreading tissue engaging members. Nowhere, either alone or

in combination, does Wilkinson discuss a biasing member connected to said first tissue engaging member and said second tissue engaging member to spread, as recited in claim 43. Furthermore, nowhere, either in alone or in combination, does Goradia discuss 1) a magnetizable material being disposed in at least one of said first and second tissue engaging members, 2) a magnetic field generator disposed in at least one of said first and second tissue engaging members, or 3) wherein generation of a magnetic field moves at least one of said first and second tissue engaging members relative to the other tissue engaging member, as recited in claim 40 from which claim 43 depends. Therefore, the Applicant respectfully requests the Examiner to withdraw this 103(a) rejection.

#### Rejoinder

With respect to claims 16 and 18, Applicant would like to reiterate that these claims should be rejoined for the following reasons. The specification and drawings as originally filed provide support these claims within at least the elected species. Referring to claim 16, for example see para [0008] and para [0046] of the published application. Referring to claim 18, for example see figures 10 and 13-15 and para [0002], [0053], [0058], [0060], and [0064]. Furthermore, claims 16 and 18 should be rejoined based on at least their dependency on claim 54. The Applicant asserts that these claims read on elected species III and respectfully requests the rejoinder of claims 16 and 18.

With respect to claims 26-31, 45, and 51-53, Applicant would like to emphasize that these claims should be rejoined for the following reasons. The specification and drawings as originally filed provide support these claims within at least the elected species, for example see figures 10 and 11 and paragraphs [0058]-[0060]. Furthermore, if claim 26 is deemed to be allowable, claims 27-31, 45, and 51-53 should be rejoined based on their dependency. The Applicant asserts that these claims read on elected species III and respectfully requests the rejoinder of claims 26-31, 45, and 51-53.

Conclusion

In view of the foregoing, reconsideration and allowance of claims 1-7, 16-19, 24, 26-61 are solicited.

The Examiner is asked to carefully review the independent claims 1, 26, and 40. The changes to the claims do not necessarily require a further search. If the Examiner considers the independent claims allowable in light of the corrections and the remarks, then the Examiner should enter the amendment and allow the case even though the new dependent claims may have required a further search.

Petition for extension is herewith made. The extension fee for response within a period of one month pursuant to Section 1.136(a) in the amount of \$65 in accordance with Section 1.17 is enclosed herewith. If a further extension of time for this paper is required, petition for extension is herewith made. A payment of \$104 is attached to provide for four (4) additional total claims.

No other fees are believed to be due for this submission. However, please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 503410 (Docket No. 780-A04-002-1).

Respectfully submitted,

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